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In re Application of
SAWHILL, Robert Arthur, et al.
Application No.: 09/786,740
PCT No.: PCT/SG98/00068
Int. Filing Date: 09 September 1998
Priority Date:
Attorney Docket No.: A34089 PCT USA
For: INTERFACE DEVICE BETWEEN
TESTING EQUIPMENT AND
INTEGRATED CIRCUIT

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This is in response to applicants' "PETITION PURSUANT TO 37 C.F.R. §1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 03 July 2002.

BACKGROUND

On 09 September 1998, applicants filed international application PCT/SG98/00068. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 16 March 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 04 April 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 09 March 2001.

On 08 March 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 23 April 2001, USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required. The NOTIFICATION set a two-month extendable period for reply.

On 23 October 2001, applicants filed "Petition Pursuant to 37 C.F.R. §1.47(a)" accompanied by, *inter alia*, a petition for a four-month extension of time, the fee for a four-month extension of time, the Notification of Missing Requirements dated 23 April 2001, an assignment, a combined declaration and power of attorney and a declaration under 37 CFR §1.47(a).

On 06 December 2001, USPTO mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicants that the application had gone abandoned for failure to timely respond to the Notification of Missing Requirements (Form PCT/DO/EO/905).

On 14 December 2001, applicants submitted faxed copies of the 23 October 2001 petition

under 37 CFR 1.47(a), which were accompanied by, *inter alia*, a petition for a four-month extension of time; the fee for a four-month extension of time; a declaration of the inventors executed by Robert Arthur Sawhill; a declaration of Mr. Sawhill; and a copy of a letter to Mr. Shah and the registered article delivery receipt marked "Undeliverable." A copy of the Notification of Missing Requirements (Form PCT/DO/EO/905) was not included.

On 04 February 2002, the Office mailed Decision on Petition Under 37 CFR 1.47(a) dismissing applicants' petition without prejudice.

On 03 July 2002, applicants submitted the instant renewed petition with a petition for a three month extension of time and the fee for a three month extension of time.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1), (3) and (4) were previously met. However, applicants now indicate that Mr. Shah's address is 555 East El Camino Real #610; Sunnyvale, CA 94087. Additionally, in the email to Mr. Shah, Mr. Sawhill indicates that the declaration incorrectly lists both Mr. Shah's residence and nationality. As such, the declaration does not comply with 37 CFR 1.497 (a)-(b). Item (4) has not been met.

Item (2) has not been met. Applicants assert that Mr. Shah has refused to sign after presentation with a full copy of the application papers and the declaration. It is not clear from Mr. Shah's email that he is refusing to sign the declaration. Rather, it appears he is questioning the necessity of the assignment and is refusing to sign it. An assignment is not required to file a patent application.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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